



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,060	03/02/2000	Andrew Scott Field	KDO.188020-1	5292
25763 7590 04/17/2007 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498			EXAMINER POND, ROBERT M	
			ART UNIT 3625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/17/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/518,060

Applicant(s)

FIELD ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 January 2007 has been entered.

Response to Amendment

The Applicant amended claim 2. Claims 1, 3-7, and 12-22 are canceled. All pending claims (2 and 8-11) were examined in this non-final office action. This office action clarifies the teachings cited in Greulich. The Applicant is reminded that twice-rejected claims are eligible for appeal.

Response to Arguments

Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection. Greulich remains the primary reference given it discloses key aspects of the claimed invention. Although based on technology that pre-dates the use of web browsers and Java script, it was determined that the second controlling means used to

control the second computing means (i.e. customer computer) is executing pricing routines at the customer's computer to provide the customer with substantially instantaneous price quotes without making requests to the first computing means connected via a network. Cheng, also assigned to Moore Business Forms, provides the teachings necessary enhance the capabilities of Greulich's business forms creating and pricing with business forms and full color brochure creation and pricing.

Arguments based on the inoperative claim element in claim 2 (see 112 rejection below) against Greulich are defective. Greulich can calculate a price based on selecting one or more options once the initial minimum number of options is selected. For example, once the user inputs a minimum number of options to compute a price, the user can change the quantity option to receive an immediate pricing update without making requests to the first computing means as noted below under 103(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 2 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.**

The claim element “automatically calculating a price quote based on the one or more printing configuration options selected by the customer...” is inoperative due to an omitted step. The customer must first select a minimum number of options necessary to calculate a price before calculating a price based on selecting just one option. This is supported in the provisional application and non-provisional instant specification.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 1. Claims 2 and 8-11 are rejected under 35 USC 103(a) as being unpatentable over Greulich (Paper #20050401, US 5,241,464) in view of Cheng (US 6,012,070), further in view of Edwards (cited in Paper #2, PTO-892, Item: U).**

Greulich teaches a system and method for creating and ordering custom business forms. Greulich's system comprises i) a first computing means 10 at a first location, the first location being an order reception facility of a business forms manufacturer (see Fig. 1 (10); col. 4, lines 39-48), ii) a second computing means 13 at a second location remote from the first location (e.g. customer's office) (see Fig. 1 (13); col. 4, lines 39-53) with first control means for creating a business form and second control means for controlling the second computing means 13 and storing pricing information (see col. 5, lines 3-5). Greulich teaches

the second control means controlling the customer's input for specifying options using the second computing means 13 and embodied as a graphical display on the customer's computer (see Fig. 3; Fig. 4). Please note: pricing is discussed in two ways- updated pricing that is sent to the second controlling means so that the second controlling means can calculate the correct pricing for an order based on current prices when the customer inputs option parameters (e.g. form type, quantity, etc.). Greulich further teaches:

- providing a customer a real-time graphic user interface associated with a printing service provider (as noted above, see at least Fig. 4; col. 6, lines 37-66), which included a pricing engine (second control means includes means for controlling the second computing means to calculate prices once sufficient order and business form parameter data has been inputted, see at least col. 2, lines 57-62;), wherein the pricing engine includes one or more printing configuration options, in which the customer selects the one or more printing configuration options (second controlling means for second computing means can calculate pricing for an order at the second computing means, see Fig. 3; Fig. 4). Please refer to Edwards below for web browser teaching.
- automatically calculating a price quote based on the one or more printing configuration options selected by the customer, wherein the pricing engine automatically and substantially instantaneously calculates a new price quote each time the customer selects or enters data for one or more new

configuration options at the customer before forwarding to the processing computer at the printing service provider; second control means includes means for controlling the second computing means to calculate prices once sufficient order and business form parameter data has been inputted; as illustrated in Fig. 9b, in the quantity routine (executed on the customer's computer), updated pricing information is sent (64) to a subroutine to be stored and to be ultimately used to calculate a price when enough information has been received to calculate a price. Price is recalculated and updated as more options are added (see at least Fig. 2; Fig. 7; Fig. 9b; col. 2, lines 57-62; col. 8, lines 62-68). Please note:

- displaying automatically said price quote at the customer; second computing means automatically calculates the price, sales tax, and the amount of the total order (see at least Fig. 4 (41); col. 6, line 67 through col. 7, line 5).
- receiving from said customer a digital graphic layout file to be printed; create forma having a wide variety of parameters, designs, verbiage at the customer's computer (see at least col. 1, lines 53-56); first control means for controlling the second computing means to custom design a plurality of first parameters of a business form, to produce a custom business form in machine format, and first communication means for transmitting the custom form in machine format from the second computing means to the first computing means (see at least col. 2, line 28-66).

Art Unit: 3625

- obtaining payment from the customer. customer makes payment using credit card, cash on delivery, or account (see at least col. 9, lines 35-51).
- using a global information and communication network; communicates using public telephone lines via modem connection (see at least Fig. 1; col. 5, lines 30-37).
- delivering to the customer. processed order is shipped to the customer (see at least col. 6, lines 12-16).

Although Greulich, assigned to Moore Business Forms, does not disclose converting the customer-provided digital graphic layout file to a processed press-ready file with a format compatible for full color-printing, Greulich in view of Cheng (assigned to Moore Business Forms) teach and suggest the claimed invention. Greulich teaches all the above as noted under the 103(a) rejection and teaches a) a computerized system and method for creating and automatically pricing a business forms order with color information at the customer's computer, and b) transmitting to the production site the order in machine format. On the other hand, Cheng teaches a system and method of creating by an end-user, either a customized business form or color brochure using templates to facilitate production of the customized business form or color brochure at the customer's workstation, and transmitting the digital file to a production station without the need to transmit a final document with high resolution color graphics in physical form. Cheng further teaches color brochures and full/four-color printing, and pre-press and press-ready production (see at least abstract; Fig. 1; col. 1, lines 18-

44); col. 4, lines 25-40; col. 11, lines 49-64). Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to modify Greulich for the customer to provide a digital graphic layout file in a format compatible with full-color printing as taught by Cheng, in order to process both business forms and color brochures used in business, and thereby attract customers to the online service.

Greulich and Cheng teach all the above as noted under the 103(a) rejection and teach i) the second computing means (i.e. customer computer) displaying to the customer the printed page layout graphically (Greulich: see at least Fig. 9AB) prior to completing the order, ii) transmitting the order file in machine format to the first computing means (i.e. production site) (Greulich: see at least Fig. 9AD-9AF), iii) the production site receiving and proofing the layout and determining corrections are required (Greulich: see at least Fig. 10A; Fig. 10B (76), and iv) contacting the customer and advising corrections (Greulich: see at least Fig. 10B ("Is Proof OK?)). Although Greulich and Cheng do not disclose customer approval, it would have been obvious to one of ordinary skill in the art at time the invention was made to ascertain Greulich and Cheng are attempting seek approval from the customer to make corrections noted during the proofing process using a printed format.

Although Greulich and Cheng do not specify the format of the proof, it would have been obvious to one of ordinary skill in the art at time the invention was made to ascertain that any of the formats taught by Greulich and Cheng

(proofing, compressed image formats for electronic transmission, or physical transfer format on a floppy disk) provide delivery alternatives for proofing.

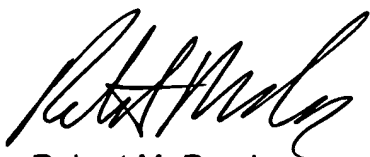
Greulich and Cheng teach all the above as noted under the 103(a) rejection and teach using displaying forms and brochure ordering information on a graphical user interface. Although Greulich and Cheng do not disclose the use of a web browser or a global communication and information network, Edwards teaches the explosive growth of the Internet and World Wide Web and subsequent competitive impact on the forms and business printing industry (see at least page1). Edwards further teaches web browsers as the means for interfacing with a remote user over the Internet (see at least page 1). Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to upgrade Greulich and Cheng's graphical user interface and modem-to-modem connections to the web browsers and the Internet as taught by Edwards, in order for businesses in the printing industry to be competitive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond
Primary Examiner
April 15, 2007